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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,696	08/18/2003	Jay C. Song	IP-022856	5096

7590 03/30/2005

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/643,696	<b>Applicant(s)</b> SONG ET AL	
	<b>Examiner</b> D. S. Nakarani	<b>Art Unit</b> 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                        |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/03 &amp; 03/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

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### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5-7, 9, 14, 19, 23, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Leskela et al (WO 01/55793 A1).

Leskela et al disclose a coated paper comprising a paper substrate coated with a coating composition comprising at least three pigments and binder such as styrene-butadiene acrylic copolymers (page 7, lines 3-11). Leskela et al's pigment includes calcium carbonate, kaolin and gypsum (page 5, lines 10-30). Leskela et al also disclose pigments such as titanium dioxide, plastic pigments, aluminum silicate, talc, aluminum hydroxide etc. (page 6, lines 18-24). Leskela et al also disclose addition of lubricant such as sulfonated oils, esters, amines, calcium or ammonium stearate etc (page 7, lines 17-18). Leskela et al's coated paper is useful in

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electrophotography (Abstract). Leskela et al disclose a pigment particle size of less than 0.5 microns (page 6, lines 11-17).

4. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leskela et al (WO 01/55793 A1) in view of Normington et al (U.S. Patent No. 5,952,082).

Leskela et al, which has been discussed above, fail to disclose claimed additional number of pigments, glass transition temperature of the binder resin, particle size of plastic pigments, polymethyl methacrylate pigment, claimed internal bond strength, claimed gloss and Parker Print surface.

Normington et al disclose electrophotographic recording medium comprising paper coated with a coating composition comprising clay, carbonate, plastic pigment, starch and latex binder (column 5, lines 55-60, Table and column 7, lines 25-45). Normington et al disclose Parker Print smoothness 2.1-2.3. Normington et al also disclose conventional paper having Parker Print smoothness 1.38-1.42 (Table 1). Normington et al disclose 75° TAPPI gloss of 35-50 for a medium gloss paper and 65-90 for high gloss paper (column 5, lines 30-39). Normington et al disclose that the plastic pigments aids in achieving gloss on the paper during calendaring (column 6, line 61 to column 7, line 1).

Therefore, in absence of showing criticality of number of pigments, claimed Scott internal bond of the coated paper, co-efficient of fraction and a surface resistivity, a person of ordinary skill in the art at the time of this invention made to utilize disclosure of Normington et al in the invention of Leskela et al to make a coated paper having required properties for electrographic printing. Use of number of pigments is dependent on required color of the coated

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paper. It is well known in the coating art to color match coating for desired color using number of colored pigments.

No claims are allowed.


5. Receipt of Information Disclosure Statements file October 9, 2003 and March 3, 2004 is acknowledged. All references have been made of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday from 7 a.m. to 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D.S. Nakarani/dh  
March 16, 2005

  
**D. S. NAKARANI**  
**PRIMARY EXAMINER**